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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,256	03/01/2002	Kishan Khemani	11527.354	4244

22913 7590 09/09/2004

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/087,256	KHEMANI ET AL.	
	Examiner	Art Unit	
	Ana L. Woodward	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

Three

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/7/2002, 8/28/2002, 2/6/2003, 6/24/2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/7/02, 8/28/02, 2/6/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-3, 7-12 and 14-25, in the reply filed on June 24, 2004 is acknowledged.
2. Claims 4-6 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 24, 2004.
3. Claims 1-3, 7-12 and 14-25 are generic to a plurality of disclosed patentably distinct species comprising the various materials defining the soft polymer and the various materials defining the stiff polymer. The election of an ultimate species of soft polymer and an ultimate species of stiff polymer is requested. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 112

4. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the Markush groups defining the polymers constitute improper format.

In claim 2, line 2, "modified" is indefinite as to scope and meaning.

In claim 2, line 3, it is unclear how ester groups, i.e., terephthalate groups, can be substituted with an aliphatic diacid monomer. Do applicants intend **ester** units formed from said aliphatic diacid?

In claim 2, no distinction can be seen between the generic polyesteramide per line 4 and the specific polyesteramide per lines 5-6.

In claim 3, it is unclear how the generic polyester per lines 3-4 distinguishes over the aliphatic-aromatic copolyester per lines 5-7.

In claim 3, it is unclear how the generic polyester formed from succinic acid per line 5, distinguishes over the succinate-containing polyesters per line 8.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 7-12 and 23-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,252,642 (Sinclair et al) in view of U.S. 6,465,573 (Maruko et al)

Sinclair et al disclose degradable compositions comprising blends of a poly(lactic acid), meeting the presently claimed stiff polymer, and an elastomeric polymer, such as a Hytrel polyester elastomer, meeting the presently claimed soft polymer. The experimental Table demonstrates compositions 2-5 meeting the compositional requirements of the above-rejected claims.

The above-rejection is based on the premise that the lactic acid polymers of the reference are the same as the presently claimed polylactic acid materials and, as such, inherently contain the same the glass transition temperatures. It is noted that the reference's Hytrel 4056 elastomer material has a glass transition temperature of -29 C (Maruko et al's Table 6).

With respect to the functional limitations, e.g., "suitable for formation into at least one of sheets or films", given that the reference composition is useful for producing packaging items, it is reasonable to believe that said functional limitations are met by the reference's composition. The onus is shifted to applicants to establish otherwise.

8. Claims 1-3, 7-12 and 23-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,810,545 (Tsai et al).

Tsai et al disclose biodegradable thermoplastic compositions comprising an unreacted mixture of a poly(lactic acid) polymer, reading on the presently claimed stiff

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polymer, and a polybutylene succinate polymer or a polybutylene succinate adipate polymer or a mixture of such polymers, reading on the presently claimed soft polymer. The experimental Table 3 demonstrates various compositions meeting the compositional requirements of the above-rejected claims.

The above-rejection is based on the premise that the lactic acid polymers and succinate-based polyesters of the reference are the same as the corresponding component of the present claims and, as such, inherently contain the same the glass transition temperatures.

With respect to the functional limitations, e.g., "suitable for formation into at least one of sheets or films", given that the reference composition is useful for producing top sheets, it is reasonable to believe that said functional limitations are met by the reference's composition.

Claim Rejections - 35 USC § 103

9. Claims 14-22 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,252,642 (Sinclair et al) described hereinabove in view of U.S. 5,180,765 (Sinclair).

Sinclair et al '642 differs in essence from the above-rejected claims in not expressly disclosing the use of fillers. In this regard, attention is directed to Sinclair '765 for the conventionality of incorporating fillers into biodegradable packaging thermoplastics from lactides for modification of the properties thereof (column 15, lines 60-68). Accordingly, it is maintained that it would have been obvious to one having ordinary skill in the art to have employed a filler, for its expected additive effects, into the composition of Sinclair et al '642, absent evidence of unusual or unexpected results.

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10. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,910,545 (Tsai et al) described hereinabove.

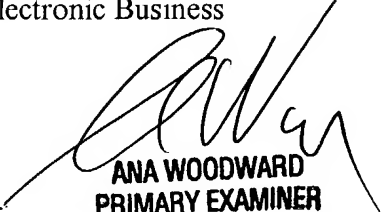
Tsai et al differs in essence from the above-rejected claims in not expressly exemplifying the use of fillers. In this regard, attention is directed to column 8, line 33, wherein patentees disclose that the composition can additionally incorporate other components, such as particulates. Accordingly, it is maintained that it would have been obvious to one having ordinary skill in the art to have employed a filler, for its expected additive effects, into the composition of Tsai et al, absent evidence of unusual or unexpected results.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANA WOODWARD
PRIMARY EXAMINER